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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/628,033	07/25/2003	Paul Harold Bryson	66140P029	3354

8791 7590 04/19/2006

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EXAMINER

YU, GINA C

ART UNIT PAPER NUMBER

1617

DATE MAILED: 04/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/628,033

Applicant(s)

BRYSON ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Receipt is acknowledged of amendment filed on January 17, 2006. Claims 1-15 are pending. Claim rejections made under 35 U.S.C. § 112, second paragraph, as indicated in the previous Office action dated October 12, 2005 are withdrawn in view of claim amendment made by applicants. Claim rejections made under 35 U.S.C. §§ 102 and 103 as indicated in the same Office action are withdrawn in view of the claim amendment. New rejections are made to address new claim limitations.

#### ***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 5, 7, 8, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by (Flick, Cosmetic and Toiletry Formulations, 2001).**

Flick (2001) discloses a moisturizing body wash comprising 15 % of disodium dimethicone copolyol sulfosuccinate, propylene glycol and glycerin, polyquaternium – 39, and carbomer (a polymer viscosity modulator). See p. 30; instant claims 1, 7, 8. The formulation contains SM2169, which is a nonionic emulsion of dimethicone and laureth-4 and laureth-23. See instant claim 14. Less than 1 % of an alpha-hydroxy acid includes zero content of the component. See instant claim 5

**Claims 1, 5-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Braun et al. (Rheology Modifiers Handbook).**

Braun et al. disclose a hair cosmetic composition comprising 4 % of glycerin, 10 % by weight of cyclomethicone and dimethiconol, 4 % of Incroquat Behenyl TMS (a

quaternium, behenyltrimonium methosulfate/cetearyl alcohol), 2 % of polyvinyl pyrrolidone vinyl acetate copolymer (about 1 % polymer viscosity modulator); and 78.80 % of water. See instant claims 1, 6, 7, 9. Less than 1 % of an alpha-hydroxy acid includes zero content of the component. See instant claim 5

**Claims 1-5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Clarke et al. (US 4818523).**

Clarke et al. disclose hair conditioning composition comprising 0.50 % of a glycol (propylene glycol), 1 % of a silicone (cyclomethicone), 1 % of a quaternium (dodecyl trimethyl ammonium chloride), and a polymeric thickener (hydroxyethylcellulose). See instant claims 1 and 7. See Example 2; col. 9, lines 20 – 52.

The reference teaches that cyclic or linear silicone is used in amount of about 0.5 – about 1.5 %, which reads on the claimed amount of 2 %. See col. 6, lines 41 –58. The composition also comprises Germaben II which is a mixture of parabens. See instant claim 13. The reference teaches making the composition in the range of pH 3-4. See col. 9, lines 20-51. See instant claims 2-4. Less than 1 % of an alpha-hydroxy acid includes zero content of the component. See instant claim 5. See also col. 8, lines 44 – 48, which teaches that suitable acids such as citric acid can be used to adjust pH if needed.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1, 2, 5-8, 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable by Flick (Cosmetic and Toiletry Formulations, 1997).**

Flick (1997) teaches a topical skin treatment emulsion comprising 4.76 % wt glycerin (glycol), 1.43 % of Veegum and 0.29 % of xanthan gum (polymeric viscosity modifiers), 1.43 % of dimethicone, 7.14 % of glycolic acid (67 % solution), 63.51 % of water, and cetyl alcohol. The pH is in the range of 3.5 – 4. See instant claims 1, 2, 5-8, 13, 14. The claimed method of topically applying the composition is an obvious use of the topical product. See instant claim 15.

While Flick teaches using 1.43 % of dimethicone, it is noted that differences in concentration generally will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, it is viewed that discovering the optimum or workable range of silicone copolymer or silicone oil by routine experimentation would have been obvious to the skilled artisan. See instant claims 1 and 6.

**Claims 1, 5-11, 13, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patt et al. (US 6927205 B2).**

Example 4 discloses an emulsion comprising propylene glycol, quaternium 82, polyquaternium-37, PPG-1-trideceth-6, cetyl dimethicone copolyol and parabens. See instant claims 1, 7, 10, 13, and 14. Less than 1 % of an alpha-hydroxy acid includes

zero content of the component. See instant claim 5. Example 6 teaches a high silicone content cream comprising 50 % of dimethicone, 44 % of water, behenyltrimonium [sic] methosulfate /cetearyl alcohol. See instant claim 9. Example 2 uses jojoba oil, which is a vegetable oil. See instant claims 8 and 11.

While the Patt reference does not specifically teach using the silicone in the amount of “about 4-30%” as claimed by applicants, it is noted that differences in concentration generally will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In this case, the reference illustrates the use of cetyl dimethicone copolyol in 1 % and dimethicone in 50 %, while the claimed amount requires 2-30 % % and about 4 – about 30 %. The use of the silicone as skin conditioning or protecting agent is also taught. See col. 12, line 52 – col. 13, line 10. It is viewed that discovering the optimum or workable range of silicone copolymer or silicone oil by routine experimentation to produce a cosmetic composition with skin conditioning or protecting property would have been obvious to a skilled artisan.

**Claims 1, 5, 7-9, 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Espinoza (US 6709773 B2).**

Espinoza teaches cosmetic compositions. The reference teaches multivesicular emulsion drug delivery composition. The reference teaches using a mixture of

behentrimonium methosulfate, which is derived from rapeseed oil, and cetearyl alcohol as an emulsifier. See col. 2, line 61, line 3, line 60. See instant claims 9 and 11. A sample sunscreen lotion formulation contains 3 % of Incroquat Behenyl TMS, 4 % of glycerin, 66.2 % of water, and avocado oil. See instant claims 1, 6, 11-13. Glycols including glycerin, propylene glycol, and butylene glycol are also taught as solvent and moisturizers in col. 5, lines 3-10 and lines 37 – 55, and used in sample formulations. Preservatives including parabens are taught in col. 5, lines 24 – 37. The reference also teaches that moisturizers dimethicone and cyclomethicone are used in 1 % and 5 %, respectively, by weight of a composition. See Self-tanning cream in col. 6, line 62 – col. 7, line 9; col. 5, lines 38 – 56.

While the reference does not disclose a specific formulation comprising a polymer viscosity modulator, using polymeric viscosity modifiers such as hydroxyethylcellulose, xanthan gum, and veegum are taught in col. 4, line 55 – col. 5, line 2. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the composition of the sample formulation by adding the polymeric viscosity modifiers as taught by the reference to make a composition with increased viscosity.

### ***Response to Arguments***

Applicant's arguments filed on January 17, 2006 have been fully considered but they are not persuasive in part and moot in view of new ground of rejection in part.

With respect to the anticipation rejection made in view of Flick (1997), applicants assert that the prior art does not necessarily teach the claimed method step of rubbing

the composition into the skin because there are other ways to distribute the composition, such as spray or bath. While the rejection is not withdrawn in view of the claim amendment made by applicants, examiner notes that the argument is not persuasive because the claimed composition is a cream, which is to be spread and rubbed on the skin because of the viscosity and rheology of the composition.

Applicants assert that the composition "may be applied to the skin without rubbing and/or removed after application". The argument is unpersuasive and lacks objective, factual support. In fact, the reference specifically notes that the composition is used to deliver glycolic acid, and it is obvious that the composition is to be remained on the skin rather than washed off after application.

Regarding the anticipation rejection made in view of Clark et al. applicants assert that the reference fails to teach the claimed amount of silicone. The argument is moot in view of the new grounds of rejection. As pointed out above, the reference teaches that about 1.5 % of silicone is used to make the prior art composition. The claimed amount, 2 %, is within the range of "about 1.5 %" as taught by the reference.

With respect to the anticipation rejection made in view of Patt, applicants assert that the reference fails to teach the claimed amount of silicone. The argument is moot in view of the new ground of rejection as discussed above.

With respect to the obviousness rejection made in view of Espinoza, applicants assert that the rejection fails because the reference does not point out to the claimed amount of silicone. The argument is moot in view of the new grounds of rejection as discussed above.



***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

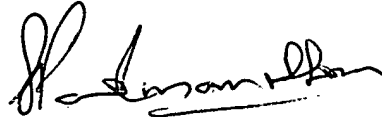
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00 AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Patent Examiner



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**